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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,036	06/23/2003	Matthew McQuaid	61022.00001	9535
30256	7590	08/25/2005	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P 600 HANSEN WAY PALO ALTO, CA 94304-1043			MARMOR II, CHARLES ALAN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/602,036

Applicant(s)

MCQUAID, MATTHEW

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-13, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is responsive to the Amendment filed May 25, 2005. The Examiner acknowledges the amendments to the specification; the amendments to claims 1, 6, 7, 11-14, 21 and 22; and the cancellation of claims 15-20 and 23-28. Claims 1-14, 21 and 22 are pending.

#### *Drawings*

2. The objections to the drawings set forth in the Office Action of February 22, 2005 are withdrawn.

#### *Claim Objections*

3. Claim 7 is objected to because of the following informalities: in lines 1-2, "further comprising gripping ridges," is redundant and should be deleted. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6, 10-13, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lay ('302). Lay teaches a container attachment that is capable of receiving and capturing a fluid

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specimen. The attachment includes an attachment ring (7) adapted for attachment to a specimen container (35) and a peripheral wall (17) extending from the attachment ring. The peripheral wall (17) has a base, an outer edge, and areas that may be considered receiving (25) and capturing (23) means. The outer edge of the peripheral wall includes a *generally* U-shaped region (26) extending towards the base of the peripheral wall that is located in a means capable of receiving semen or urine from a penis or urethra (25) in the peripheral wall. A portion of the peripheral wall forming a means capable of capturing semen or urine (23) faces the generally U-shaped receiving space (26) of the “receiving means” (25) of the peripheral wall. The attachment ring has a threaded portion (43) on an inner side of the attachment ring. The attachment ring has a snap on mechanism (63). An outer side of the attachment ring has a plurality of elongated gripping ridges that are generally evenly spaced apart around the outer side of the attachment ring, such that the longitudinal axes of the gripping ridges extend substantially perpendicular to a plane in which the attachment ring lies (see Figure 5). The U-shaped region of the outer edge of the peripheral wall has an arcuate lower portion positioned towards the base of the peripheral wall. The U-shaped region of the outer edge of the peripheral wall has a generally smooth and rounded exterior surface. The outer edge of the peripheral wall has a pair of side regions extending between the receiving and capturing means of the peripheral wall. The side regions slope downwards from the upper region of the outer edge of the peripheral wall to the U-shaped region of the outer edge of the peripheral wall (see Figure 6). A specimen container (35) may be coupled to the attachment ring. The “receiving means” (25) has a lower height than the “capture means” (23) with the sidewalls sloping downwards from the “capture

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means” towards the “receiving means” to provide a gradual transition between the “capture” and “receiving” means (see Figs. 5 and 6).

6. Claims 1, 10-13, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ehrenkranz ('878). Ehrenkranz teaches a specimen container attachment that is capable of receiving and capturing a fluid specimen. The attachment includes an attachment ring (12) adapted for attachment to a specimen container (14) and a peripheral wall extending from the attachment ring. The peripheral wall has a base, an outer edge, and areas that may be considered receiving (20) and capturing (18) means. The outer edge of the peripheral wall includes a *generally* U-shaped region (see Figures 1-3b) extending towards the base of the peripheral wall that is located in a “receiving means” (20) of the peripheral wall. A portion of a “capturing means” (18) of the peripheral wall faces the generally U-shaped receiving space of the “receiving means” (20) of the peripheral wall. The U-shaped region of the outer edge of the peripheral wall has an arcuate lower portion positioned towards the base of the peripheral wall. The U-shaped region of the outer edge of the peripheral wall has a generally smooth and rounded exterior surface. The outer edge of the peripheral wall has a pair of side regions extending between the receiving and capturing means of the peripheral wall. The side regions slope downwards from the upper region of the outer edge of the peripheral wall to the U-shaped region of the outer edge of the peripheral wall. A specimen container (14) may be coupled to the attachment ring. The “receiving means” (20) has a lower height than the “capture means” (18) with the sidewalls sloping downwards from the “capture means” towards the “receiving means” to provide a gradual transition between the “capture” and “receiving” means.

7. Claims 1, 4-13, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleming ('385). Fleming teaches a container attachment that is capable of receiving and capturing a fluid specimen. The attachment includes an attachment ring (12) adapted for attachment to a specimen container (10) and a peripheral wall (15) extending from the attachment ring. The peripheral wall (15) has a base, an outer edge, and areas that may be considered receiving (18) and capturing (17) means. The outer edge of the peripheral wall includes a *generally* U-shaped region (see Figure 1) extending towards the base of the peripheral wall that is located in the "receiving means" (18) of the peripheral wall. A portion of the "capturing means" (17) of the peripheral wall faces the generally U-shaped receiving space of the "receiving means" (18) of the peripheral wall. An outer side (13) of the attachment ring has a plurality of elongated gripping ridges that are generally evenly spaced apart around the outer side of the attachment ring, such that the longitudinal axes of the gripping ridges extend substantially perpendicular to a plane in which the attachment ring lies (see Figures 1 and 2). The lower ends of the gripping ridges are positioned adjacent a bottom edge of the attachment ring which may include an annular lip (14, see Fig. 3). The upper ends of the gripping edges are positioned towards and spaced apart from a top edge of the attachment ring (see Figs. 1 and 2), such that the upper edges of the gripping ridges lie in a plane substantially parallel to the plane of the top edge of the attachment ring. The U-shaped region of the outer edge of the peripheral wall has an arcuate lower portion positioned towards the base of the peripheral wall (see Fig. 1). The U-shaped region of the outer edge of the peripheral wall has a generally smooth and rounded exterior surface. The outer edge of the peripheral wall has a pair of side regions extending

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between the receiving and capturing means of the peripheral wall. The side regions slope downwards from the upper region of the outer edge of the peripheral wall to the U-shaped region of the outer edge of the peripheral wall. A specimen container (10) may be coupled to the attachment ring. The “receiving means” (18) has a lower height than the “capture means” (17) with the sidewalls sloping downwards from the “capture means” towards the “receiving means” to provide a gradual transition between the “capture” and “receiving” means (see Figs. 1-3).

8. Claims 1, 10-13, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tokarz et al. ('572). Tokarz et al. teaches a specimen container attachment that is capable of receiving and capturing a fluid specimen. The attachment includes an attachment ring (14) adapted for attachment to a specimen container (15) and a peripheral wall (11) extending from the attachment ring. The peripheral wall has a base, an outer edge, and areas that may be considered receiving and capturing means (see Figures 1, 2 and 4-8). The outer edge of the peripheral wall includes a *generally* U-shaped region (see Figures 1, 2 and 4-8) extending towards the base of the peripheral wall that is located in a “receiving means” of the peripheral wall. A portion of a “capturing means” of the peripheral wall faces the generally U-shaped receiving space of the “receiving means” of the peripheral wall. The U-shaped region of the outer edge of the peripheral wall has an arcuate lower portion positioned towards the base of the peripheral wall. The U-shaped region of the outer edge of the peripheral wall has a generally smooth and rounded exterior surface. The outer edge of the peripheral wall has a pair of side regions extending between the receiving and capturing means of the peripheral wall. The side regions slope downwards from the upper region of the outer edge of the peripheral wall to the U-



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shaped region of the outer edge of the peripheral wall. A specimen container (15) may be coupled to the attachment ring. The “receiving means” has a lower height than the “capture means” with the sidewalls sloping downwards from the “capture means” towards the “receiving means” to provide a gradual transition between the “capture” and “receiving” means.

### *Allowable Subject Matter*

9. Claim 14 is allowable over the prior art of record.
10. The following is a statement of reasons for the indication of allowable subject matter:

No prior art of record teach or fairly suggest a specimen container attachment in combination with a specimen container, where the specimen container attachment and the specimen container comprise the combination of structural elements recited in claim 14.

### *Response to Arguments*

11. Applicant's arguments filed May 25, 2005 have been fully considered but they are not persuasive. Applicant contends that no prior art of record teach or fairly suggest a specimen container attachment having means for receiving and capturing biological fluid. The Examiner respectfully disagrees. The Examiner submits that the limitations “receiving means for receiving semen or urine from a penis or a urethra, respectively” and “capturing means for capturing the semen or urine” add no structure to the claimed apparatus. For example, these limitations do not add any sort of structure as would a limitation such as “receiving means for receiving a penis and collecting semen or urine therefrom,” where this limitation would require the receiving means to



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have a size and shape sufficient to receive a penis. Each of the container attachments disclosed by Lay, Ehrenkranz, Fleming and Tokarz et al. appear to have structural means that appear fully capable of "receiving semen or urine from a penis or a urethra, respectively" and "capturing means for capturing the semen or urine." In view of the forgoing, the rejections under 35 USC 102(b) as being anticipated by at least one of Lay, Ehrenkranz and Fleming are maintained.

### *Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

cam  
August 22, 2005